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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/606,806

06/27/2003

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45316

5901

7590

06/13/2008

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EXAMINER

AL AUBAIDI, RASHA S

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

06/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |  |                                   |  |
|------------------------------|--|-----------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/606,806   | <b>Applicant(s)</b><br>KIM ET AL. |  |
|                              | <b>Examiner</b><br>RASHA S. AL AUBAIDI | <b>Art Unit</b><br>2614           |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This in response to amendment filed 02/13/2008. No claims have been added. No claims have been canceled. No claims have been amended. Claims 1-19 are still pending in this application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (US PAT # 6,738,373).

Regarding claim 1, Turner teaches a method of controlling the operation mode of a hybrid access terminal (HAT) (see col. 4, lines 44-65) capable of communicating a first communication system that supports voice service and low-speed data service and a second communication system that supports high-speed data service (see col. 2, lines 5, lines 1-9), the method comprising the steps of: monitoring both the first and second communication systems in a hybrid operation mode by the HAT (col. 2, lines 58-64); and transitioning from the hybrid operation mode to a data-only operation mode (col. 5, lines 4-16), upon receipt of a message ordering mode transition from the second communication system (the message reads on the PDSN data packets received from the base station, see col. 5, lines 25-32).

Turner does not specifically teach discontinuing monitoring the first communication system, and monitoring only the second communication system by the HAT.

However, Turner discloses that WCD can actually monitors only the first network channel (see col. 2, lines 57-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the HAT monitoring the second communication system instead of the first communication system. This is strictly a design choice the HAT can be programmed to monitor any network desired and discontinue monitoring

the other network (not in use). Also, dropping the monitoring for the other communication network it would have been obvious in the Turner's system, since there is no need to exhaust the recourses when is not needed it.

Claims 10, 12-13 and 16-17 are rejected for the same reasons as discussed above with respect to claim 1.

For claims 2-3, 4-8, see col. 2, lines 37-63.

For claims 9, 11, 14-15 and 18-19, see col. 1, lines 14-54.

### ***Response to Arguments***

4. Applicant's arguments have been considered but they have been found not persuasive.

Regarding Applicant's arguments (Pages 7-9 of the Remarks), it is noted that Applicant's main argument are directed to "Turner does not teach, show, suggest, or render obvious the claimed step of discontinuing monitoring the first communication system, and monitoring on the second communication system by the HAT". Applicant states (Page 8 of the Remarks) that since Turner recognizes that operating first and second communication system has an impact on standby time, Turner operates only the communication system in service in order to save power. The Applicant reached the

conclusion that by periodically saving power and operating the communication system in service only, Turner is actually teaching away from Applicant's claimed step of discontinuing monitoring the first communication system and monitoring only the second communication system. The Examiner respectfully disagrees with Applicant's statement because as stated in the above rejection that dropping/discontinuing the monitoring for the other communication network (not in use) it will avoid exhausting the recourses. Why an ordinary skill in the art will continue monitoring two communication systems one is operative (i.e., working) and the other is idle (i.e., not in use), doing so will require to maintain power and resources for two communication systems, which in reality only the communication system that is operative is required monitoring and not the other . The Examiner believes that discontinuing the monitoring of one communication system when it is not needed is one method of saving power and energy and it is absolutely analogs to Turner's teaching of saving power by limiting the time for monitoring, concentrating mostly on the communication system that is in service (i.e., in use) which is considered another method of saving power and energy. Both methods leads to the same end result.

Applicant argues (Page 9 of the Remarks) "However, singling messages are not wrapped and transmitted to the HAT while the second channel is transmitting data packets". It is noted that Applicant is reading into the claim language, since the claimed limitation of "while the second channel is transmitting data packets" is not recited in claim 12.

The Examiner believes that other claims arguments are already addressed.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S. AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (571) 272-7488.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rasha S AL-Aubaidi/

Primary Examiner, Art Unit 2614